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I. STATUS OF CLAIMS

Claims 1-26 were pending for examination at the time of the office action. No claim amendments have been made.

Claims 1-4, 9, 12-15, 20 and 23-26 stand rejected under 35 USC §102(e) as being anticipated by Ferri et al. (U.S. Pub. No. 2005/0275532) (hereinafter “Ferri”). See Office Action, p. 2 (23 May, 2008).

Claims 5-7 and 16-18 stand rejected under 35 USC §103(a) as being unpatentable over Ferri in view of Chin et al. (U.S. Pub. No. 2004/0090326) (hereinafter Chin) See Office Action, p. 4 (23 May, 2008).

Claims 10, 11, 21 and 22 stand rejected under 35 USC §103(a) as being unpatentable over Ferri in view of Herrmann et al. (U.S. Pub. No. 2003/0151513) (hereinafter Herrmann) See Office Action, p. 5 (23 May, 2008).

Claims 1-26 remain pending for examination.

II. ISSUES TO BE REVIEWED

The issues in this response relate to whether the art of record establishes a *prima facie* case of anticipation of Applicant’s Claims 1-26, and whether the art of record establishes a *prima facie* case of unpatentability of Applicant’s Claims 1-26. For reasons set forth elsewhere herein, Applicant respectfully asserts that the art of record does not establish a *prima facie* case of anticipation or unpatentability of any pending claim. Accordingly, Applicant respectfully requests that Examiner hold all pending Claims 1-26 allowable for at least the reasons described herein, and issue a Notice of Allowance on same.

III. ARGUMENT: ART OF RECORD DOES NOT ESTABLISH PRIMA FACIE CASE OF UNPATENTABILITY IN VIEW OF CITED ART OF RECORD

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability as set forth below, the art of record does not establish a *prima facie* case of the unpatentability of Applicant’s claims at issue. Specifically, Applicant respectfully shows below that the art of record does not recite the text of Applicant’s claims at issue,

and hence fails to establish a *prima facie* case of unpatentability. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections and hold all claims to be allowable over the art of record.

A. MPEP Standards for Patentability¹

The MPEP states as follows: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. . . . If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)); *In Re Glaug*, 283 F.3d 1335, 62 USPQ2d 1151 (Fed. Cir. 2002) (“During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 252 U.S.P.Q. 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent.”). Accordingly, unless and until an examiner presents evidence establishing *prima facie* unpatentability, an applicant is entitled to a patent on all claims presented for examination.

1. MPEP Standards for Determining Anticipation

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 521 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....”)). Failure of an examiner to meet this burden entitles an applicant to a patent. *Id.* (“[i]f examination at the initial

¹ Applicant is aware that Examiner is familiar with the MPEP standards. Applicant is merely setting forth the MPEP standards to serve as a framework for Applicant’s arguments following and to ensure a complete written record is established. Should Examiner disagree with Applicant’s characterization of the MPEP standards, Applicant respectfully requests correction.

stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent”).

The MPEP indicates that in order for an examiner to establish a *prima facie* case of anticipation of an applicant’s claim, the examiner must first interpret the claim,² and thereafter show that the cited prior art discloses the same elements, in the same arrangement, as the elements of the claim which the examiner asserts is anticipated. More specifically, the MPEP states that “[a] claim is anticipated *only if each and every element as set forth in the claim is found*, either expressly or inherently described, in a single prior art reference. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim. . . . The elements must be arranged as required by the claim” *MPEP* § 2131 (emphasis added). Consequently, under the guidelines of the MPEP set forth above, if there is *any* substantial difference between the prior art cited by an examiner and an applicant’s claim which the examiner asserts is rendered anticipated by the prior art, the prior art does NOT establish a *prima facie* case of anticipation and, barring other rejections, the applicant is entitled to a patent on such claim.

2. MPEP Standards for Determining Obviousness

“[T]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.”³ *MPEP* § 2142. The MPEP indicates that in order for an examiner to establish a *prima facie* case that an invention, as defined by a claim at issue, is obvious, the examiner must (1) interpret the claim at issue; (2) define one or more prior art reference components relevant to the claim at issue; (3) ascertain the differences between the one or more prior art reference components and the elements of the claim at

² With respect to interpreting a claim at issue, the MPEP directs that, during examination -- as opposed to subsequent to issue -- such claim be interpreted as broadly as the claim terms would reasonably allow, in light of the specification, when read by one skilled in the art with which the claimed invention is most closely connected. *MPEP* § 2111.

³ An invention, as embodied in the claims, is rendered obvious if an examiner concludes that although the claimed invention is not identically disclosed or described in a reference, the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *MPEP* § 2141 (citing 35 U.S.C. § 103).

issue; and (4) adduce objective evidence which establishes, under a preponderance of the evidence standard, a teaching to modify the teachings of the prior art reference components such that the prior art reference components can be used to construct a device substantially equivalent to the claim at issue. This last step generally encompasses two sub-steps: (1) adducement of objective evidence teaching how to modify the prior art components to achieve the individual elements of the claim at issue; and (2) adducement of objective evidence teaching how to combine the modified individual components such that the claim at issue, as a whole, is achieved. *MPEP* § 2141; *MPEP* § 2143. Each of these forgoing elements is further defined within the *MPEP*. *Id.*

This requirement has been explained recently by the Supreme Court in *KSR v. Teleflex*, 550 U.S. ____; 127 S. Ct. 1727 (2007) which noted that such a rejection requires "some articulated reasoning ... to support the legal conclusion of obviousness." As stated by the Court, obviousness can be established where "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, *this analysis should be made explicit.*" (*emphasis added*) See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'). *KSR v. Teleflex*, 550 U.S. ____; 127 S. Ct. 1727 at 1741.

As further described by the Court "*[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.* Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR v. Teleflex*, 550 U.S. ____; 127 S. Ct. 1727 at 1741.

a) Interpreting a Claim at Issue

With respect to interpreting a claim at issue, the MPEP directs that, during examination -- as opposed to subsequent to issue -- such claim be interpreted as broadly as the claim terms would reasonably allow when read by one skilled in the art with which the claimed invention is most closely connected. In practice, this is achieved by giving each of the terms in the claim the "plain meaning" of the terms as such would be understood by those having ordinary skill in the art, and if portions of the claim have no "plain meaning" within the art, or are ambiguous as used in a claim, then the examiner is to consult the specification for clarification. *MPEP* § 2111.

b) Definition of One or More Prior Art Reference Components Relevant to the Claim at Issue

Once the claim at issue has been properly interpreted, the next step is the definition of one or more prior art reference components (*e.g.*, electrical, mechanical, or other components set forth in a prior art reference) relevant to the properly interpreted claim at issue. With respect to the definition of one or more prior art reference components relevant to the claim at issue, the MPEP defines three proper sources of such prior art reference components, with the further requirement that each such source must have been extant at the time of invention to be considered relevant. These three sources are as follows: patents as defined by 35 U.S.C. §102, printed publications as defined by 35 U.S.C. §102, and information (*e.g.*, scientific principles) deemed to be "well known in the art"⁴ as defined under 35 U.S.C. §102. *MPEP* § 2141; *MPEP* § 2144.

⁴ The fact that information deemed to be "well known in the art" can serve as a proper source of prior art reference components seems to open the door to subjectivity, but such is not the case. As a remedy to this potential problem, *MPEP* § 2144.03 states that if an examiner asserts that his position is derived from and/or is supported by a teaching or suggestion that is alleged to have been "well known in the art," and that if an applicant traverses such an assertion (that something was "well known within the art"), the examiner must cite a reference in support of his or her position. The same MPEP section also states that when a rejection is based on facts within the personal knowledge of an examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. *Id.* Thus, all sources of prior art reference components must be objectively verifiable.

c) **Ascertainment of Differences between Prior Art Reference Components and Claim at Issue; Teaching to Modify and/or Combine Prior Art Reference Components to Remedy Those Differences in Order to Achieve Recitations of Claim at Issue**

With one or more prior art components so defined and drawn from the proper prior art sources, the differences between the one or more prior art reference components and the elements of the claim at issue are to be ascertained. Thereafter, in order to establish a case of *prima facie* obviousness, an examiner must set forth a rationale, supported by objective evidence⁵ sufficient to demonstrate under a preponderance of the evidence standard, that in the prior art extant at the time of invention there was a teaching to modify and/or combine the one or more prior art reference components to construct a device practicably equivalent to the claim at issue.

The preferable evidence relied upon is an express teaching to modify/combine within the properly defined objectively verifiable sources of prior art. In the absence of such express teaching, an examiner may attempt to establish a rationale to support a finding of such teaching reasoned from, or based upon, express teachings taken from the defined proper sources of such evidence (*i.e.*, properly defined objectively verifiable sources of prior art). *MPEP* § 2144; *In re Dembiczaik*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

The MPEP recognizes the pitfalls associated with the tendency to subconsciously use impermissible "hindsight" when an examiner attempts to establish such a rationale. The MPEP has set forth at least two rules to ensure against the likelihood of such impermissible use of hindsight. The first rule is that:

under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information,⁶ the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at

⁵ The proper sources of the objective evidence supporting the rationale are the defined proper sources of prior art reference components, discussed above, with the addition of factually similar legal precedent. *MPEP* § 2144.

⁶ "Factual information" is information actually existing or occurring, as distinguished from mere supposition or opinion. *Black's Law Dictionary* 532 (5th ed. 1979).

that time to that person. Knowledge of an Applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search, and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon an Applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP § 2142 (emphasis added). Thus, if the only objective evidence of such teaching to modify and/or combine prior art reference components is an applicant's disclosure, no evidence of such teaching exists.⁷

The second rule is that if an examiner attempts to rely on some advantage or expected beneficial result that would have been produced by a modification and/or combination of the prior art reference components as evidence to support a rationale to establish such teachings to modify and/or combine prior art reference components, the MPEP requires that such advantage or expected beneficial result be objectively verifiable teachings present in the acceptable sources of prior art (or drawn from a convincing line of reasoning based on objectively verifiable established scientific principles or teachings). *MPEP* § 2144. Thus, as a guide to avoid the use of impermissible hindsight, these rules from the MPEP make clear that absent some objective evidence, sufficient to persuade under a preponderance of the evidence standard, no teaching of such modification and/or combination exists.⁸

⁷ An applicant may argue that an examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *MPEP* § 2145(X)(A) (emphasis added).

⁸ *In Re Sang Su Lee* 277 F.3d 1338 (Fed. Cir. 2002) ("When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.") See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors). "*The factual inquiry whether to combine references must be thorough and searching.*" *Id.* *It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.* See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000) ("showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1522 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999,

B. Technical Material Cited by Examiner (Ferri et al. (U.S. Pub. No. 2005/0275532) Is Not a Valid Reference; Notice of Allowance of Same Respectfully Requested

1. Independent Claim 1

Independent Claim 1 recites:

1. A method comprising: transmitting at least a part of one or more mote-addressed content indexes.

As shown in the following, the technical material cited by the Examiner is not a valid 102(e) reference for Independent Claim 1. Accordingly, Applicant respectfully requests that Examiner allow Independent Claim 1.

a) Technical Material Cited by Examiner is Not a Valid Reference for the Text of at Least Independent Claim 1.

As set forth above, Independent Claim 1 recites:

1. A method comprising: transmitting at least a part of one or more mote-addressed content indexes.

With respect to Claim 1, Examiner has stated,

50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined *only* if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)). The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”)).

"Claims 1-4, 9, 12-15, 20 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferri et al. (US 2005/0275532) (hereinafter Ferri)." See Examiner's *Office Action*, p. 2 (May 23, 2008).

(1) Examiner Citations With Regard to Independent Claim 1

Applicant respectfully points out that Applicant has reviewed the Ferri reference identified by Examiner, and so far as Applicant can discern, Ferri does not have a filing date prior to the Applicant's filing date (March 31, 2004). Rather, the Ferri reference cited by Examiner has a May 28, 2004 filing date.

35 U.S.C. 102(e) states that:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language. (emphasis added) Thus, because applicants filing date is prior to the Ferri filing date, Examiner's assertions regarding Ferri are untenable. Under the statute as set forth above, the cited art of record fails to establish a *prima facie* case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 1 allowable and issue a Notice of Allowability of same.

In view of the foregoing, and under the 35 USC Section 102(e) statute as set forth above, Applicant respectfully submits that the Examiner-cited art does not establish a *prima facie* case of unpatentability of Independent Claim 1. Accordingly, for at least the foregoing reasons, Applicant respectfully asks Examiner to hold Independent Claim 1 allowable and to issue a Notice of Allowance of same.

2. Dependent Claims 2-11: Patentable for at Least Reasons of Dependency from Independent Claim 1.

Claims 2-11 depend either directly or indirectly from Independent Claim 1. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. §112 paragraph 4. Consequently, Dependent Claims 2-11 are patentable for at least the reasons why Independent Claim 1 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 2-11 patentable for at least the foregoing reasons, and issue a Notice of Allowance on same.

3. Independent Claim 12

Independent Claim 12 recites:

12. A system comprising: means for transmitting at least a part of one or more mote-addressed content indexes.

As shown in the following, the technical material cited by the Examiner is not a valid 102(e) reference for Independent Claim 12. Accordingly, Applicant respectfully requests that Examiner allow Independent Claim 12.

- a) **Technical Material Cited by Examiner is Not a Valid Reference for the Text of at Least Independent Claim 12.**

As set forth above, Independent Claim 12 recites:

12. A system comprising: means for transmitting at least a part of one or more mote-addressed content indexes.

With respect to Claim 12, Examiner has stated,

"Claims 1-4, 9, 12-15, 20 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferri et al. (US 2005/0275532) (hereinafter Ferri)." See Examiner's *Office Action*, p. 2 (May 23, 2008).

(1) Examiner Citations With Regard to Independent Claim 12

Applicant respectfully points out that Applicant has reviewed the Ferri reference identified by Examiner, and so far as Applicant can discern, Ferri does not have a filing date prior to the Applicants filing date (March 31, 2004). Rather, the Ferri reference cited by Examiner has a May 28, 2004 filing date.

35 U.S.C. 102(e) states that:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language. (emphasis added) Thus, because applicants filing date is prior to the Ferri filing date, Examiner's assertions regarding Ferri are untenable. Under the statute as set forth above, the cited art of record fails to establish a *prima facie* case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 12 allowable and issue a Notice of Allowability of same.

In view of the foregoing, and under the 35 USC Section 102(e) statute as set forth above, Applicant respectfully submits that the Examiner-cited art does not establish a *prima facie* case of unpatentability of Independent Claim 12. Accordingly, for at least the foregoing reasons, Applicant respectfully asks Examiner to hold Independent Claim 12 allowable and to issue a Notice of Allowance of same.

4. Dependent Claims 13-22: Patentable for at Least Reasons of Dependency from Independent Claim 12.

Claims 13-22 depend either directly or indirectly from Independent Claim 12. "A claim in dependent form shall be construed to incorporate by reference all

the limitations of the claim to which it refers." *See* 35 U.S.C. §112 paragraph 4. Consequently, Dependent Claims 13-22 are patentable for at least the reasons why Independent Claim 12 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 13-22 patentable for at least the foregoing reasons, and issue a Notice of Allowance on same.

5. Independent Claim 23

Independent Claim 23 recites:

23. A system comprising: a mote; and means for transmitting at least a part of one or more mote-addressed content indexes, said means for transmitting proximate to a portion of said mote.

As shown in the following, the technical material cited by the Examiner is not a valid 102(e) reference for Independent Claim 23. Accordingly, Applicant respectfully requests that Examiner allow Independent Claim 23.

a) Technical Material Cited by Examiner is Not a Valid Reference for the Text of at Least Independent Claim 23.

As set forth above, Independent Claim 23 recites:

23. A system comprising: a mote; and means for transmitting at least a part of one or more mote-addressed content indexes, said means for transmitting proximate to a portion of said mote..

With respect to Claim 23, Examiner has stated,

"Claims 1-4, 9, 12-15, 20 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferri et al. (US 2005/0275532) (hereinafter Ferri)." *See* Examiner's *Office Action*, p. 2 (May 23, 2008).

(1) Examiner Citations With Regard to Independent Claim 23

Applicant respectfully points out that Applicant has reviewed the Ferri reference identified by Examiner, and so far as Applicant can discern, Ferri does not have a filing

date prior to the Applicants filing date (March 31, 2004). Rather, the Ferri reference cited by Examiner has a May 28, 2004 filing date.

35 U.S.C. 102(e) states that:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language. (emphasis added) Thus, because applicants filing date is prior to the Ferri filing date, Examiner's assertions regarding Ferri are untenable. Under the statute as set forth above, the cited art of record fails to establish a *prima facie* case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 23 allowable and issue a Notice of Allowability of same.

In view of the foregoing, and under the 35 USC Section 102(e) statute as set forth above, Applicant respectfully submits that the Examiner-cited art does not establish a *prima facie* case of unpatentability of Independent Claim 23. Accordingly, for at least the foregoing reasons, Applicant respectfully asks Examiner to hold Independent Claim 23 allowable and to issue a Notice of Allowance of same.

6. Independent Claim 24

Independent Claim 24 recites:

24. A system comprising: at least one mote-addressed content index having at least one of a sensing index, a control index, or a routing/spatial index of a mote-appropriate device of a mote; and at least one reporting entity resident on the mote, said at least one reporting entity configured to report at least a part of said at least one mote-addressed content index..

As shown in the following, the technical material cited by the Examiner is not a valid 102(e) reference for Independent Claim 24. Accordingly, Applicant respectfully requests that Examiner allow Independent Claim 24.

a) Technical Material Cited by Examiner is Not a Valid Reference for the Text of at Least Independent Claim 24.

As set forth above, Independent Claim 24 recites:

24. A system comprising: at least one mote-addressed content index having at least one of a sensing index, a control index, or a routing/spatial index of a mote-appropriate device of a mote; and at least one reporting entity resident on the mote, said at least one reporting entity configured to report at least a part of said at least one mote-addressed content index..

With respect to Claim 24, Examiner has stated,

“Claims 1-4, 9, 12-15, 20 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferri et al. (US 2005/0275532) (hereinafter Ferri).”
See Examiner’s Office Action, p. 2 (May 23, 2008).

(1) Examiner Citations With Regard to Independent Claim 24

Applicant respectfully points out that Applicant has reviewed the Ferri reference identified by Examiner, and so far as Applicant can discern, Ferri does not have a filing date prior to the Applicants filing date (March 31, 2004). Rather, the Ferri reference cited by Examiner has a May 28, 2004 filing date.

35 U.S.C. 102(e) states that:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the

international application designated the United States and was published under Article 21 (2) of such treaty in the English language. (emphasis added) Thus, because applicants filing date is prior to the Ferri filing date, Examiner's assertions regarding Ferri are untenable. Under the statute as set forth above, the cited art of record fails to establish a *prima facie* case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 24 allowable and issue a Notice of Allowability of same.

In view of the foregoing, and under the 35 USC Section 102(e) statute as set forth above, Applicant respectfully submits that the Examiner-cited art does not establish a *prima facie* case of unpatentability of Independent Claim 24. Accordingly, for at least the foregoing reasons, Applicant respectfully asks Examiner to hold Independent Claim 24 allowable and to issue a Notice of Allowance of same.

7. Dependent Claims 25-26: Patentable for at Least Reasons of Dependency from Independent Claim 24.

Claims 25-26 depend either directly or indirectly from Independent Claim 24. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." *See* 35 U.S.C. §112 paragraph 4. Consequently, Dependent Claims 25-26 are patentable for at least the reasons why Independent Claim 24 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 25-26 patentable for at least the foregoing reasons, and issue a Notice of Allowance on same.

IV. CONCLUSION

Insofar as that the Applicant may have during the course of prosecution cancelled/amended/argued claims sufficient to obtain a Notice of Allowability of all claims pending, Applicant may not have during the course of prosecution explicitly addressed all rejections and/or statements in Examiner's Office Actions. The fact that rejections and/or statements may not be explicitly addressed during the course of prosecution should NOT be taken as an admission of any sort, and Applicant hereby reserves any and all rights to contest such rejections and/or statements at a later time.

Specifically, no waiver (legal, factual, or otherwise), implicit or explicit, is hereby intended (*e.g.*, with respect to any facts of which Examiner took Official Notice, and/or for which Examiner has supplied no objective showing, Applicant hereby contests those facts and requests express documentary proof of such facts at such time at which such facts may become relevant). For example, although not expressly set forth during the course of prosecution, Applicant continues to assert all points of (*e.g.* caused by, resulting from, responsive to, etc.) any previous Office Action, and no waiver (legal, factual, or otherwise), implicit or explicit, is hereby intended. Specifically, insofar as that Applicant does not consider the cancelled/unamended/argued claims to be unpatentable, Applicant hereby gives notice that it may intend to file and/or has filed a continuing application in order prosecute such cancelled/unamended/argued claims.

The Examiner is invited to contact Dale Barr (360) 627-7147 or Dale R. Cook at (425) 467-2260 with any issues that may advance prosecution of the application on the merits.

Respectfully submitted,

/Dale C. Barr, Reg. No. 40,498/

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